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10/023,565	12/18/2001	Alan D. Cetel	EH-10559	2683

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Pratt & Whitney  
Legal Department-Patent Group  
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EXAMINER
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SHEEHAN, JOHN P

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 07/20/2006

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/023,565  
Filing Date: December 18, 2001  
Appellant(s): CETEL, ALAN D.

**MAILED**  
JUL 20 2006  
**GROUP 1700**

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F. Tyler Morrison  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed May 11, 2006 appealing from the Office action mailed October 18, 2004.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

WO 99/67435	Esser et al.	12-1999
EP 0 855 449 A1	Mitsubishi et al.	7-1998

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

In the Final Rejection, mailed October 18, 2004, claims 1 to 3 and 5 to 14 (all of the claims remaining in the application) were rejected under 35 U.S.C. 103(a) as being unpatentable over Esser et al. (Esser, WO 99/67435) or Mitsuhashi et al. (Mitsuhashi, EPO Document No. 0 855 449 A1) in a single statement of the rejection. For the sake of clarity the Examiner has decided to set forth each of the rejections of claims 1 to 3 and 5 to 14 over Esser et al. (Esser, WO 99/67435) or Mitsuhashi et al. (Mitsuhashi, EPO Document No. 0 855 449 A1) separately as follows.

**Rejection Based On Esser**

Claims 1 to 3 and 4 to 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Esser et al. (Esser, WO 99/67435).

Esser teaches a directionally solidified (DS) nickel base super alloy (Abstract) having a composition that overlaps the alloy recited in applicants' claims (page 4, line 21 to page 5, line 15) and the use of the disclosed alloy in making gas turbine engine parts (page 5, lines 16 to 20). Esser teaches that the disclosed directionally solidified nickel based alloy typically has a plurality of grains as is recited in appellants' claims 1 to 3, 5 to 11, 13 and 14. It is noted that applicants' claim 12 recites that the claimed alloy is "for use in columnar grain directionally solidified articles" (claim 12, line 2, emphasis added

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by the Examiner). Thus, claim 12 does not require that the claimed alloy is actually in a columnar grain directionally solidified form. Esser also teaches that the disclosed alloy includes 0.4 to about 1.5 volume % of a phase based on tantalum carbide (page 6, lines 2 to 5) as is claimed in each of claims 1 to 3 and 5 to 14. In view of the use of the phrases, "up to" (claim 1, line 6) and "less than" (claim 12, line 5) used in the instant claims to describe the zirconium content of the claimed alloy, the applicants' claims are considered to encompass 0% zirconium. The following table compares Esser's disclosed alloy (page 4, lines 21 to page 5, line 15 and page 6, lines 2 to 5) and the alloy composition recited in applicants' independent claims.

	<u>Esser</u>	<u>Applicants'</u> <u>Claim 1</u>	<u>Applicants'</u> <u>Claim 12</u>
Cr	9.5-14%	10-13.5%	12%
Co	7 to 11%	8-10%	9%
Mo	1-2.5%	1.25-2.5%	1.9%
W	3-6%	3.25-4.25%	3.8%
Ta	1-6%	4.5-6.0%	5%
Al	3-4%	3.25-4.5%	3.6%
Ti	3-5%	3-4.75%	4.1%
Nb	0-1%	No Intentional Addition	No Intentional Addition
B	0.003-0.015%	0.0025-0.025%	0.015%
Zr	Silent	Up to about 0.05% Which encompasses 0%	less than 0.02% Which encompasses 0%

C	0.05-0.11%	0.05-0.15%	0.1%
Phase Based On Tantalum Carbide	0.4 to 1.5 vol.%	0.4 to 1.5 vol.%	0.4 to 1.5 vol.%

Esser's silence with regard to the disclosed alloy containing any Zr is considered to mean that Esser's alloy does not contain Zr.

The claims and Esser differ in that Esser: (1) does not teach the exact same alloy proportions; (2) does not disclose the use of Zr; and (3) is silent with respect to the properties recited in the claims.

However one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because applicants' claims recite Zr proportions that encompass 0% Zr, that is, these claims do not require Zr. Further, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the alloy proportions taught by each of the references overlap the instantly claimed proportions and therefore are considered to establish a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art references, particularly in view of the fact that;

"The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages", In re Peterson 65 USPQ2d 1379 (CAFC 2003).

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Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

Finally, regarding the properties recited in the claims, it is the Examiner's position that in view of the fact that Esser's alloys have compositions that overlap the alloy compositions recited in the instant claims and have the exact same amount of a phase based on tantalum carbide, Esser's alloys would be expected to possess all the same properties as recited in the instant claims, In re Best, 195 USPQ, 430 and MPEP 2112.01.

"Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, In re Best, 195 USPQ 430, 433 (CCPA 1977). 'When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.' In re Spada, 15 USPQ2d 655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. In re Best, 195 USPQ 430, 433 (CCPA 1977)." see MPEP 2112.01.

### **Rejection Based On Mitsuhashi**

Claims 1 to 3 and 5 to 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuhashi et al. (Mitsuhashi, EPO Document No. 0 855 449 A1).

Mitsuhashi teaches a nickel base columnar grain directionally solidified super alloy (page 3, lines 39 to 46) having a composition that overlaps the alloy recited in applicants' claims (page 3, lines 23 to 45) and the use of the disclosed alloy in turbine engine parts (page 3, lines 23 to 26). In view of the use of the phrases, "up to" (claim 1, line 6) and "less than" (claim 12, line 5) used in the instant claims to describe the

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zirconium content of the claimed alloy, the applicants' claims are considered to encompass 0% zirconium. Mitsuhashi teaches that the disclosed alloy is Zr free (page 3, lines 43 and page 7, lines 5 to 13). Thus, with respect to zirconium, Mitsuhashi is considered to encompass the instantly claimed alloy containing 0% zirconium. The following table compares Mitsuhashi's disclosed alloy (page 4, lines 15 to 20) and the alloy composition recited in applicants' independent claims.

	<u>Mitsuhashi</u>	<u>Applicants'</u> <u>Claim 1</u>	<u>Applicants'</u> <u>Claim 12</u>
Cr	12-14.3%	10-13.5%	12%
Co	8.5 to 11%	8-10%	9%
Mo	1-3.5%	1.25-2.5%	1.9%
W	3.5-6.2%	3.25-4.25%	3.8%
Ta	3-5.5%	4.5-6.0%	5%
Al	3.5-4.5%	3.25-4.5%	3.6%
Ti	2-3.2%	3-4.75%	4.1%
Nb	Silent	No Intentional Addition	No Intentional Addition
B	0.005-0.05%	0.0025-0.025%	0.015%
Zr	Free of (pg. 3, line 42 and pg. 7, lines, 5 to 13)	Up to about 0.05% Which encompasses 0%	less than 0.02% Which encompasses 0%
C	0.04-0.12%	0.05-0.15%	0.1%



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Phase Based On Tantalum Carbide	Silent	0.4 to 1.5 vol. %	0.4 to 1.5 vol. %
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The claims and Mitsuhashi differ in that Mitsuhashi: (1) does not teach the exact same alloy proportions; (2) does not disclose the use of Zr; and (3) is silent with respect to the properties recited in the claims and the presence of tantalum carbides.

However one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because as explained above, applicants' claims recite Zr proportions that encompass 0% Zr, that is, the claims do not require Zr and thus with respect to Zr content these claims are considered to be encompassed by Mitsuhashi's Zr free alloy. Further, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the alloy proportions taught Mitsuhashi overlap the instantly claimed proportions and therefore are considered to establish a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in Mitsuhashi, particularly in view of the fact that;

"The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages", In re Peterson 65 USPQ2d 1379 (CAFC 2003).

Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

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Finally, regarding the properties recited in the claims and the presence of tantalum carbides, it is the Examiner's position that in view of the fact that the alloys taught by Mitsuhashi have compositions that overlap the alloy compositions recited in the instant claims, Mitsuhashi's alloys would be expected to possess all the same properties as recited in the instant claims, *In re Best*, 195 USPQ, 430 and MPEP 2112.01.

"Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, *In re Best*, 195 USPQ 430, 433 (CCPA 1977). 'When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.' *In re Spada*, 15 USPQ2d 655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 195 USPQ 430, 433 (CCPA 1977)." see MPEP 2112.01.

### **Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 to 3 and 5 to 14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 to 18 of US 2004/0200549 which is copending US Patent Application No. 10/315,704. Although the conflicting claims are not identical, they are not patentably distinct from each other because the alloy compositions recited in these two sets of inventions overlap each other. One of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the claimed alloy proportions in US 2004/0200459 overlap the instantly claimed proportions and therefore are considered to establish a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

“The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages”, In re Peterson 65 USPQ2d 1379 (CAFC 2003).

Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05. .

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1 to 3 and 4 to 14 are directed to an invention not patentably distinct from claims 1 to 18 of commonly assigned US 2004/0200549 (US Patent No. 10/315,704). Specifically, the alloy compositions recited in these two sets of inventions overlap each other.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned US 2004/0200459, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

**(10) Response to Argument**

**Response to Appellants' Arguments Regarding Esser**

Appellants, referring to Esser's Tables I and II, state that, "it appears that C content rather than B content or any suggestion (outside of Esser) of Zr content is what drives the desirable results (good DS castings – comparing the results of heat 1, with those of 1A and 2)" (Brief, page 3, 2<sup>nd</sup> paragraph under the heading "*VII Argument*"). The Examiner is not persuaded. First, appellants have not explained how they arrived at their conclusion based on the data in Esser's Table I and II, that is, appellants have not explained how the data in Esser's Tables I and II support appellants' conclusion. Second, appellants have not explained how their conclusion distinguishes the claimed invention from Esser. Third, appellants' conclusion is contradictory to Esser's own disclosure in that Esser states that boron is responsible for the improved properties of the disclosed alloy (Esser, page 4, lines 14 to 17) and that carbon only in combination with boron contributes to the improved properties (Esser, page 5, first full paragraph).

Appellants, referring to pages 4 and 5 of Esser (the Examiner assumes that applicants are referring to the paragraph bridging Esser's pages 4 and 5), state that there is no mention of Zr and no mention of C (Brief, paragraph bridging pages 3 and 4). The Examiner is not persuaded. Again, appellants have not explained how their statement regarding this embodiment taught by Esser distinguishes the claimed invention from Esser. Regarding the Zr content of the claimed invention, in view of the use of the phrases, "up to" (claim 1, line 6) and "less than" (claim 12, line 5) used in the instant claims to describe the zirconium content of the claimed alloy, the applicants'

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claims are considered to encompass 0% zirconium. Thus, appellants' claimed alloy encompasses Esser's alloy which as set forth in the statement of the rejection does not contain Zr. Regarding the C content, it is the Examiner's position that Esser teaches as a preferred embodiment a carbon content of 0.05 to 0.11% (Esser, page 5, line 15 and the last line) which as can be seen from the table set forth above in the statement of the rejection overlaps the C content recited in appellants' claims.

Appellants argue that the heat treatment applied to Esser's alloy if applied to the present invention would destroy the part (Brief, page 4, second full paragraph). This is not persuasive. Appellants have not provided any evidence in support of their allegation that the heat treatment applied to Esser's alloy if applied to the present invention would destroy the part. Further, appellants' claims are not directed to appellants' process but rather appellants' claims are directed to an alloy. Further, whether or not the heat treatment taught by Esser would destroy the part is not considered to be relevant in that appellants' claims are not directed to a process but rather appellants' claims are directed to an alloy composition, which as set forth in the statement of the rejection is obvious in view of Esser's alloy.

Appellants, referring tot Esser's Table I and II argue that Esser seems to suggest that B levels below about 0.01% result in useless alloys (Brief, page 4). The Examiner is not persuaded. Applicants have not explained how they arrived at this conclusion based on the data set forth in Esser's Table I and II. Further, even assuming for the sake of argument that appellants' interpretation of the data in Esser's Tables I and II is correct, appellants have not explained how their statement regarding boron

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distinguishes the claimed invention from Esser. Finally, as set forth in the statement of the rejection, Esser teaches appellants' boron content of 0.003 to 0.015% which overlaps the boron content of 0.0025-0.025% recited in appellants' independent claim 1 and the boron content of 0.015% recited in appellants' independent claim 12.

Appellants' argument that, "Esser does not overlap with claims 1 and 12 for Zr" (Brief, page 4) is not persuasive. As set forth in the statement of the rejection, appellants' claimed invention encompasses 0% Zr and thus encompasses Esser's alloy which as set forth in the statement of the rejection does not contain Zr.

Appellants' argument that, "Esser does not teach or suggest any oxidation or corrosion resistance values, let alone the improved (unexpectedly so, given the similarity of the compositions values of present independent claims 1 and 12" (Brief, page 4) is not persuasive. In making the rejection based on Esser, the Examiner took the position regarding the properties recited in the claims that in view of the fact that Esser's alloys have compositions that overlap the alloy compositions recited in the instant claims and have the exact same amount of a phase based on tantalum carbide, Esser's alloys would be expected to possess all the same properties as recited in the instant claims, In re Best, 195 USPQ, 430 and MPEP 2112.01.

"Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, In re Best, 195 USPQ 430, 433 (CCPA 1977). 'When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.' In re Spada, 15 USPQ2d 655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not

necessarily possess the characteristics of the claimed product. In re Best, 195 USPQ 430, 433 (CCPA 1977)." see MPEP 2112.01.

Appellants have not rebutted this position taken by the Examiner. Further, appellants have not provided any evidence in support of their position that the instantly claimed alloys possess unexpectedly improved oxidation and corrosion resistance. "It is well settled that unexpected results must be established by factual evidence. Mere argument or conclusory statements in the specification do not suffice." In re Deblauwe, 222 USPQ 191, 196 (Fed. Cir. 1984). Mere lawyer's arguments and conclusory statements in the specification, unsupported by objective evidence, are insufficient to establish unexpected results." In re Wood, Whittaker, Stirling and Ohta, 199 USPQ 137, 140 (CCPA 1978).

**Response to Appellants' Arguments Regarding Mitsuhashi**

Appellants, referring to Mitsuhashi's page 4, lines 17 to 18, argue that Mitsuhashi discloses a desire to include Pt, Rh, Re, Ca and Mg in the disclosed alloy (Brief, page 5). This is not persuasive. Mitsuhashi discloses that the disclosed alloy may (Mitsuhashi, page 4, line 19) include Pt, Rh, Re, Ca and Mg. In view of Mitsuhashi's use of the word, "may" the use of Pt, Rh, Re, Ca and Mg is considered to be optional. Further, each of appellants' independent claims 1 and 12 employ the open transitional phrase "comprising". Thus, appellants' claims do not preclude the presence of any additional elements such as Pt, Rh, Re, Ca and Mg in any amount

The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps.



See, e.g., *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004)

See MPEP 2111.03

Appellants argue that the heat treatments taught by Mitsushashi would render parts of the instant application useless and are not required for the instantly claims alloy (Brief, page 5). This is not persuasive in that appellants have not provided any evidence in support of their allegation that, the heat treatments taught by Mitsushashi would render parts of the instant application useless. Further, whether or not the heat treatment taught by Mitsushashi is not required for the instantly claimed alloys is not considered to be relevant in that appellants' claims are not directed to a process but rather appellants' claims are directed to an alloy composition, which as set forth in the statement of the rejection is obvious in view of Mitsushashi's alloy.

Regarding boron, appellants argue that while there is an overlap between the boron content taught by Mitsushashi and the instant claims, Mitsushashi "seems to suggest that lower B levels (in this case below about 0.000% wt. %) result in alloys that are not useful for directionally solidified parts" (Brief, page 5). The Examiner is not persuaded. Appellants have not cited any support for their conclusion regarding Mitsushashi's teaching regarding the boron content. Further, as set forth in the statement of the rejection Mitsushashi teaches a boron content of 0.005-0.05% (page 4, line 18) which overlaps the boron of 0.0025-0.025% and 0.015% recited in appellants' independent claims 1 and 12 respectively.

Appellants argue that Mitsushashi teaches that the Zr level must be below 5 ppm (0.0005 wt. %) while appellants' claims contain significantly higher Zr contents. This is

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not persuasive. As set forth above in the statement of the rejection, in view of the use of the phrases, "up to" (claim 1, line 6) and "less than" (claim 12, line 5) used in the instant claims to describe the zirconium content of the claimed alloy, the appellants' claims are considered to encompass 0% zirconium. Thus, the Zr content recited in appellants' claims overlaps the Zr free content taught by Mitsuhashi (Mitsuhashi, page 3, line 42 and page 7, lines 5 to 13).

Appellants' argument that, "Mitsuhashi does not teach or suggest any oxidation or corrosion resistance values, let alone the improved (unexpectedly so, given the similarity of the compositions values of present independent claims 1 and 12" (Brief, page 6) is not persuasive. In making the rejection based on Mitsuhashi, the Examiner took the position regarding the properties recited in the claims, that in view of the fact that Mitsuhashi's alloys have compositions that overlap the alloy compositions recited in the instant claims Mitsuhashi's alloys would be expected to possess all the same properties as recited in the instant claims, In re Best, 195 USPQ, 430 and MPEP 2112.01.

"Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, In re Best, 195 USPQ 430, 433 (CCPA 1977). 'When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.' In re Spada, 15 USPQ2d 655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. In re Best, 195 USPQ 430, 433 (CCPA 1977)." see MPEP 2112.01.

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Appellants have not rebutted this position taken by the Examiner. Further, appellants have not provided any evidence in support of their position that the instantly claimed alloys possess unexpectedly improved oxidation and corrosion resistance. "It is well settled that unexpected results must be established by factual evidence. Mere argument or conclusory statements in the specification do not suffice." In re Deblauwe, 222 USPQ 191, 196 (Fed. Cir. 1984). Mere lawyer's arguments and conclusory statements in the specification, unsupported by objective evidence, are insufficient to establish unexpected results." In re Wood, Whittaker, Stirling and Ohta, 199 USPQ 137, 140 (CCPA 1978).

**Response to Appellants' Arguments Regarding US 2004/0200549 Which is**

**Copending US Patent Application No. 10/315,704**

Applicants state that (1) the invention of US 2004/0200459 and the instant invention were commonly owned at the time the present invention was made; and (2) the inventors in the '459 application are the same as the inventors in the present application and that for at least these reasons the double patenting rejection has been overcome. The Examiner is not persuaded. Common ownership at the time of the instant invention and the same inventorship do not preclude or overcome a provisional obviousness type double patenting rejection. Further, it is noted that in stating that the inventions were commonly owned at the time of the instant invention appellants have referred to US 2004/0200459 and not US 2004/0200549.

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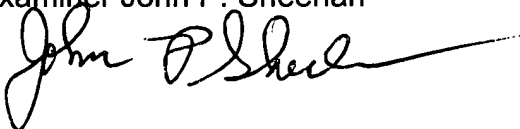
**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Examiner John P. Sheehan



Conferees:

ROY KING

SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700



CAROL CHANEY  
SUPERVISORY PATENT EXAMINER